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Dickinson Wright PLLC 38525 Woodward Avenue Suite 2000 Bloomfield Hills, MI 48304			EXAMINER HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/605,575  
Filing Date: October 09, 2003  
Appellant(s): JIANG, HAOCHUAN

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Thomas Donohue  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 March 2008 appealing from the Office action mailed 2/09/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct. However, some of the grounds are withdrawn. The status is now:

Claims 1-4, 6-8 and 10-11 are allowed.

This appeal involves claims 9 and 12-16

Claims 17-22 are withdrawn from consideration as not directed to the elected invention.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However some specific bases are withdrawn (see below). Although a

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corrected final rejection was mailed (5/8/2007) after the filing of the notice of appeal, such is not material. The differences between the versions mailed 5/8/2007 and 2/9/2007 relate only to matters that are not being maintained. Appellant appeals the rejection of Feb 9, 2007, and that is the basis for this final rejection.

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claims 1, 2, 6-8 and 10-11 are no longer rejected under the first paragraph of 35 USC 112.

The rejection under 35 USC 112 – 2<sup>nd</sup> paragraph is withdrawn.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

3,713,816

MACCRAGH

1-1973

Grant and Hackh's Chemical Dictionary, 5th ed., 1991, page 638.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 12-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the amendment of 10/12/2005 claim 9 was amended to recite that the slicing was "such that a plurality of collimator assemblies may be produced from said block with varied collimating characteristics". There is no basis for this limitation that Examiner could find.

Claim 12 there is no support for the claim 12, "sintering a high-z powder and a glass powder mixture to form a first collimator tube". First it is noted that there is no mention of "high-z powder" in the specification. The only things disclosed as being sintered is metal tungsten powder and glass powder. Although tungsten powder may be thought of as a "high-z powder", the single specie does not provide support for the entire genus of "high-z powders".

Fourth, as per MPEP 2163 II) A) 2) a) ii)

>The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]." See Enzo

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Biochem, 323 F.3d at 966, 63 USPQ2d at 1615

Thus for the “high-z powder” genus, applicant’s disclosure of only one specie (tungsten powder) does not indicate that patentee had invented species sufficient to constitute the genus. [0018] refers to different embodiments. The last embodiment is directed to sintering tungsten metal powder – there is no other mention or even suggestion of other metals, or other powders. Thus there is no indication that applicant had invented other species which would be sufficient to constitute the genus.

This is undisputed.

### **(10) Response to Argument**

It is noted that although there is assertion of evidence in the Appeal Brief, such not considered evidence. Although the evidence Appendix suggest such was provided to the Office in the 22 September 2006, such was also just an assertion of evidence. Applicant never provided any evidence commensurate with the assertion of evidence so that Examiner could fully consider and weight the asserted evidence. An assertion of evidence is deemed to be mere argument and thus carries little weight.

From **MPEP 2145 Consideration of Applicant’s Rebuttal Arguments**

I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS NECESSARY

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art.

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The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Regarding the rejection under the first paragraph of 35 USC 112, Applicant points to [0018] of the specification. However no argument points out how [0018] provides support for the genus of "high-z powder". Although the paragraph points out various oxides, including some with Z (atomic number) greater than that of tungsten, there is no suggestion that they are sintered. It is well understood that glasses are typically made by melting oxides together. If those oxides were merely sintered together, the result would be a sintered mass of the adhered oxides.

As admitted by Appellant, on page 4, line 12 of the Brief, sintering is where the particles adhere to each other - i.e. there is no mixing or forming of glass. The only disclosure of sintered powders relates to glass powder and tungsten powder. One of ordinary skill would interpret this as being the only mode of sintering two powders (one glass the other tungsten) contemplated by Appellant at the time of application.

The arguments indicate the Office made an assertion that glass powder and tungsten powder cannot be sintered. Examiner could not find any such assertion, nor does Applicant point out where this assertion is made. Examiner notes that if examiner thought the invention could not be made, Examiner would have made a non-enablement rejection. No such rejection exists. The disclosed invention is fully

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enabled. However, to the degree that the result is not glass: Appellant is correct, the resultant of sintering the two can be considered to be a glass - even if it has metal in it.

The arguments regarding the rejection of claim 9 was misplaced under the 35 USC 112 – 2<sup>nd</sup> paragraph heading. It is argued that it is well known in the art that the purpose of the tailoring is to affect performance characteristics. There is no evidence to support this assertion. Moreover, even if this was true, there is no disclosure of “tailoring” or that the alleged well-known performance characteristics are the claimed “varied collimating characteristics”.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John Hoffmann/

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/Yogendra N Gupta/

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